

# Notice of Allowability

Application No.

10/031,636

Applicant(s)

GOLDSBOROUGH, ANDREW  
SIMON

Examiner

Joyce Tung

Art Unit

1637

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1/14/2004.
2. ☒ The allowed claim(s) is/are CLAIMS 57, 59 AND 62 (final claims 1-3).
3. ☒ The drawings filed on 29 April 2002 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

- |                                                                                                                                         |                                                                                                             |
|-----------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                             | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                 |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                    | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date <u>2172004</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date <u>1128103</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                                         |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                              | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance                        |
|                                                                                                                                         | 9. <input type="checkbox"/> Other _____.                                                                    |

### EXAMINER'S AMENDMENT

Following the entry of the amendment filed 1/14/2004, the claims 57, 59 and 62 are pending.

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with John Lucas on 2/17/2003.

2. The application has been amended as follows:

In claim 59, line 3, after "a reaction system", delete "for modifying the RNA ... the ribose rings bear a substituent" and substitute therefore -- comprising a reactant that will covalently modify the 2'-OH position of the ribose rings of RNA such that a proportion of the 2'-OH positions of the ribose rings of said RNA will bear a substituent --.

In claim 59, line 6, after "a separation system", delete "for preparing isolated RNA ... from the sample on the basis of a property of the substituent" and substitute therefore -- comprising a separating material that will isolate the RNA comprising said substituent from the sample on the basis of a property of said substituent --.

In claim 62, line 4, after "a reaction system", delete "for modifying the RNA ... the ribose rings bear a substituent" and substitute therefore -- comprising a reactant that will covalently modify the 2'-OH position of the ribose rings of RNA such that a proportion of the 2'-OH positions of the ribose rings of said RNA will bear a substituent --.

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In claim 62, line 7, after “a separation system”, delete “for preparing isolated RNA ...from the sample on the basis of a property of the substituent” and substitute therefore – comprising a separating material that will isolate the RNA comprising said substituent from the sample on the basis of a property of said substituent --.

3. The following is an examiner's statement of reasons for allowance:

Concerning claims 57, 59 and 62, no prior art has been found teaching or suggesting the method of isolating RNA comprising modifying of 2'-OH position of the ribose rings of the RNA so that a proportion of the 2'-OH position of the ribose rings bear a substituent and isolating the RNA by separating the material containing the substituent from the sample, the kit and the device for isolating the RNA.

The closest prior art is the reference of Dudycz et al.. Dudycz et al. disclose the replacement of the 2'-hydroxyl group of RNA with a 2'- amino or 2'-peptido moiety. However, Dudycz et al. do not teach or suggest that the modified 2'-hydroxyl group of RNA is used for the separation or isolation of the RNA, and the kit and device for isolating RNA.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (571) 272-0790. The examiner can normally be reached on Monday - Friday, 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (571) 272-0284<sup>7</sup>. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

5. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOYCE TUNG J.T  
February 9, 2004

  
**ETHAN WHISENANT**  
**PRIMARY EXAMINER**